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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/589,104

07/26/2007

Thierry Brunelet

5460-83PUS

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03/09/2010

COHEN, PONTANI, LIEBERMAN & PAVANE LLP  
551 FIFTH AVENUE  
SUITE 1210  
NEW YORK, NY 10176

EXAMINER

CHIN, HUI H

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/09/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/589,104 | <b>Applicant(s)</b><br>BRUNELET ET AL. |  |
|                              | <b>Examiner</b><br>HUI CHIN          | <b>Art Unit</b><br>1796                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-38,43-52 and 54-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38,43-52 and 54-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/10/2006</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### *Claim Objections*

1. Claim 35 is objected to because of the following informalities:

Claim 35, line 2, "trimester" is suggested to be changed to -- triester --.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-38, 43-52 and 54-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soehnen et al. (EP 1270657) in view of Wideman et al. (US Patent 6,300,449).

Soehnen et al. disclose a rubber composition containing 30 to 90 phr of styrene butadiene copolymer, 10 to 70 phr of diene rubbers, 20 to 100 phr of silica, 1 to 15 phr of a silane coupling agent, 5 to 60 phr of a softener selected from naphthenic mineral oil softeners, MES and TDAE, 0.5 to 2.0 phr of sulphur, and vulcanization accelerators (claim 1, [0030]).

However, Soehnen et al. are silent on the use of polylimonene resin.

Wideman et al. disclose a resin composition consisting essentially of a polymer which is the reaction product of the polymerization reaction between dicyclopentadiene and limonene, said resin having a softening point ranging from about 50 to about 220°C. and a molecular weight ranging from about 500 to about 42,000 wherein 13.3 phr of limonene was used to provide a polymeric resins which are particularly useful in improving traction of the rubber when used in tire treads (claim 1, Sample 3, abstract). In light of such benefit, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the rubber composition with the limonene resin with the expected success.

The limitations of claims 8-11, 16-17, 30-31 and 36 can be found in Soehnen et al. at claim 1, where it discloses the 5 to 60 phr of a softener.

The limitations of claims 12-15, 32-35 and 49-52 can be found in Soehnen et al. at paragraph [0025], where it discloses the 5 to 20 phr of rapeseed oils.

The limitations of claims 18 and 37 can be found in Soehnen et al. at claim 4, where it discloses the natural rubber.

The limitations of claims 19-23 and 38 can be found in Soehnen et al. at claim 1, where it discloses the 20 to 100 phr of silica.

The limitations of claim 24 can be found in Soehnen et al. at paragraph [0026], where it discloses the carbon black.

The limitations of claim 25 can be found in Soehnen et al. at paragraph [0031], where it discloses the process.

The limitations of claims 43-48 and 54-58 can be found in Soehnen et al. at paragraphs [0034]-[0035], where it discloses the winter tire and tread.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUI CHIN whose telephone number is (571)270-7350. The examiner can normally be reached on Monday to Friday; 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ling-Siu Choi/  
Primary Examiner, Art Unit 1796

/HC/

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Art Unit: 1796

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